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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,077	03/26/2004	Chad Nathaniel Price	921207-95753	3511

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DAVID C. BREZINA  
BARNES & THORNBURG  
P.O. BOX 2786  
CHICAGO, IL 60690

EXAMINER

FISCHER, JUSTIN R

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/810,077

Applicant(s)

PRICE ET AL.

Examiner

Justin R. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>32604</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a bicycle wheel, classified in class 301, subclass 5.1.
  - II. Claim 7, drawn to a method of shipping, storing, and servicing bicycle wheels, classified in class 156, subclass 110.1.
2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product as claimed can be used in a materially different process of using the product, for example one in which an inner tube is not inflated and subsequently deflated (can be a tubeless tire construction).
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with David Brezina on March 28, 2006 a provisional election was made with traverse to prosecute the invention of a bicycle wheel, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claim 7 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (US 6,318,428) and further in view of Lefebvre (EP 633150). As best depicted in Figures 3 and 4, Lo is directed to a bicycle wheel construction having a tire and a rim with a tire well, spoke bed, and brake walls. The wheel construction further includes (1) a flexible seal member 13 (full width rim strip) that extends over the entire axial dimension of the tire and (2) a valve 132. Furthermore, the reference suggests that the wheel construction can be used with or without an inner tuber (Column 2, Lines 30-35). However, the sealing member 13 of Lo fails to include integral raised circumferential ridges to aid in sealing the tire. Lefebvre, on the other hand, is directed to an extremely similar wheel construction in which a seal member is provided with a pair of raised circumferential ridges in order to retain the heels of the tire against the sides of the tire (Abstract). One of ordinary skill in the art at the time of the invention would have found it obvious to include ridges in the seal member of Lo to obtain the benefits detailed above. It is emphasized that the benefits detailed by Lefebvre are analogous to those outlined in the claimed invention. Absent any conclusive showing of unexpected results, one of ordinary skill in the art at the time of the invention would have readily appreciated including ridges in the seal member of Lo. Lastly, it is unclear if the flange structure of Lo satisfies the "hook bead flanges" of the claimed invention. In any event,

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such a structure is extremely well known and conventional in the manufacture of bicycle tires, as shown for example by Lefebvre.

As to claim 6, the combination of elements of Lo in view of Lefebvre can be viewed as a "kit".

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lo and Lefebvre as applied in claim 2 above and further in view of Nakasaki (DE 3715669). In describing the seal member, Lo suggests a flexible material, **such as** rubber (Column 2, Lines 20-25). It is clearly evident that rubber is only exemplary and one of ordinary skill in the art at the time of the invention would have found it obvious to use any well-known and conventional material used in similar sealing constructions. Nakasaki recognizes the alternative use of plastics and rubber in an extremely similar sealing layer and as such, one of ordinary skill in the art at the time of the invention would have found it obvious to form the seal member of Lo from a plastic material absent any conclusive showing of unexpected results. Based on the disclosure of Nakasaki, rubber and plastics are seen to provide a sufficient seal across the tire.

8. Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo and further in view of Lefebvre and Koziattek (US 6,782,931). As detailed above, Lo in view of Lefebvre substantially teach the claimed wheel construction. The references, however, are silent as to the inclusion of a sealing material prior to inflation. However, it is well known to include a sealing material when forming similar bicycle wheel constructions, as shown for example by Koziattek (Column 2, Lines 26+). In this instance, the inclusion of a sealing material insures an airtight contact between the

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beads and the rim, which is consistent with the benefits associated with the inclusion of a seal member (as is detailed in Lo and Lefebvre). As such, one of ordinary skill in the art at the time of the invention would have found it obvious to include a sealing material in the wheel construction of Lo absent any conclusive showing of unexpected results.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Justin Fischer

April 5, 2006